

REMARKS

Claims 1-24 are pending.

Claims 1-24 stand rejected.

Appreciation is expressed for the telephonic interviews conducted on June 20, 2006 and June 26, 2006 between Examiner Schlie and Jennifer M. Anda, Applicant's representative. During the interview, the Korngiebel patent and the Applicant's admitted prior art were discussed. Agreement was reached that neither Korngiebel nor Applicant's admitted prior art teach the limitations of the independent claims 1, 9, and 17.

Rejection of Claims under 35 U.S.C. § 103

Claims 1-24 stand rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 5,416,915, Korngiebel et al., ("Korngiebel") in view of U.S. Patent Application 10/678,892, Gallo ("Gallo"). Applicants respectfully traverse this rejection.

As stated in the MPEP § 706.02 (j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See **MPEP § 2143 - § 2143.03** for decisions pertinent to each of these criteria. **Emphasis added.**

The Office Action states Korngiebel discloses "automated data storage library system...composed of multiple storage frames/modules, comprising multiple storage shelves/racks, comprising storage cells/locations for storage media...and accessed as required as a sub-component of a logical library comprised of an arbitrary site of arbitrarily located potentially dissimilar storage media...implying that their logical addressing and/or association with the logical library need not be restricted as a function of their physical location..." *See Office Action, paragraph 2.*

The cited portion of Korngiebel discloses "Multiple virtual media libraries are created within the monolithic physical library system. This capability enables the use of a plurality of types of media within the monolithic physical library system with a corresponding plurality of drive elements within the library..." (Korngiebel, column 3, lines 43-48).

In contrast, Applicants' independent claim 1, and generally independent claims 9 and 17 recite, *inter alia*:

...selecting a media type of a first storage frame;

assigning storage addresses for said plurality of storage shelves in said first storage frame;

in response to detecting said selected media type in a storage frame specified by said storage frame number:

assigning storage addresses for said plurality of storage shelves in said storage frame specified by said storage frame number, [and]

in response to detecting that storage addresses have not been assigned to said plurality of storage shelves in all of said storage frames:

setting said storage frame number to the next frame with no assigned storage addresses;

selecting a media type of said next frame with no assigned storage addresses;
returning to step D.

Regarding Korngiebel, the Applicants submit that Korngiebel does not disclose the step of, *"selecting a media type of a first storage frame" and "in response to detecting said selected media type in a storage frame specified by said storage frame number"*. Further, the Applicants submit that Korngiebel does not disclose *"in response to detecting that storage addresses have not been assigned... selecting a media type of said next frame with no assigned storage addresses"*.

Regarding Gallo, the Office action relies upon Gallo to disclose that *"Storage shelf addresses are typically assigned in a sequential order as storage shelves are encountered within each frame" (Office Action, paragraph 2)*. Gallo also does not disclose the steps of configuring the automated data storage library as recited in claims 1, 9, and 17.

Specially, the Applicants submit that Gallo does not disclose the step of *"selecting a media type of a first storage frame" and "in response to detecting said selected media type in a storage frame specified by said storage frame number"*. Further, the Applicants submit that Gallo does not disclose *"in response to detecting that storage addresses have not been assigned... selecting a media type of said next frame with no assigned storage addresses"*.

Accordingly Applicants submit that neither Korngiebel or Gallo, alone or in combination teach the steps of, *inter alia*, *"selecting a media type of a first storage frame" and "in response to detecting said selected media type in a storage frame specified by said storage frame number" or "in response to*

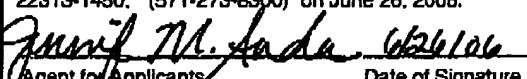

detecting that storage addresses have not been assigned... selecting a media type of said next frame with no assigned storage addresses".

Accordingly, Applicants submit that all of the claim limitations of independent claims 1, 9, and 17 have not been shown by Korngiebel in view of Gallo, alone or in combination as required by § 706.02 (j) of the MPEP. It follows then that a *prima facie* case of obviousness has not been met with respect to claims 1, 9, and 17. Accordingly, Applicants respectfully submit that claims 1, 9, and 17 are allowable for at least this reason over Korngiebel and Gallo, either alone or in combination.


Claims 2-8 depend from independent claim 1 and are allowable for at least this reason. Claims 10-16 depend from independent claim 9 and are allowable for at least this reason. Claims 18-24 depend from independent claims 17 and are allowable for at least this reason.

CONCLUSION

In view of the remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at the numbers provided below.

I hereby certify that this correspondence is being faxed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450. (571-273-8300) on June 26, 2006.	
 Agent for Applicants	 Date of Signature

Respectfully submitted,


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